

REMARKS

Applicants submits this Reply in response to the non-final Office Action mailed November 4, 2008. Before this Amendment, claims 21-40 were pending, of which claims 21 and 37 were independent. By this Amendment, Applicants have amended claims 21-37 and 40. Accordingly, claims 21-40 are currently pending, of which claims 21 and 37 are independent.

In the Office Action, the Examiner rejected claim 40 under 35 U.S.C. § 101 for purportedly being directed to non-statutory subject matter.¹ In addition, claims 21-28, 32, and 37-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,522,888 ("Garceran"). Finally, claims 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20040156372 ("Hussa") and claims 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of U.S. Patent Publication No. 20030124046 ("Riley"). Applicants respectfully traverse all pending rejections and request reconsideration of the application, as presently amended.

Rejection Under 35 U.S.C. § 101

Claim 40 was rejected under 35 U.S.C. § 101 because it

recites a "computer program product" which is not defined in the specification, and "a computer program product" that is not embodied in a functional descriptive material is neither a process ("actions"), machine, manufacture nor composition of matter (i.e., tangible "thing") and therefore does not fall within one of the four categories of § 101.

¹ The Office Action contains a number of statements reflecting characterizations of the Applicant's disclosure, including the claims, and the related art. Regardless of whether any such statement is specifically addressed herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Office Action, p. 2.

Claim 40, as presently amended, recites, among other things, a "computer-readable medium storing instructions for execution by a processing system"

Applicants respectfully submit that the computer-readable medium recited in claim 40 complies with the statutory requirements of Section 101.

It is well established that "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory." M.P.E.P. § 2106.01(I) (emphasis added). Moreover, "[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." M.P.E.P. § 2106.01.

For at least the reasons set forth in M.P.E.P. § 2106.01, the "computer-readable medium storing instructions for execution by a processing system. . ." recited in amended claim 40, comprises a tangible, functional element that is not merely drawn to software per se and is statutory in accordance with 35 U.S.C. § 101.

Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the 35 U.S.C. § 102(e) rejections of claims 21-28, 32, and 37-40 as being anticipated by Garceran. In order to properly establish an anticipation rejection under 35 U.S.C. § 102(e), every element of the claims at issue must be found in the applied prior-art reference, either expressly or under principles of

inherency. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In this case, Garceran fails to teach or suggest each and every element of Applicants' claimed invention.

Specifically, Garceran does not disclose or suggest at least Applicants' claimed "method for locating a terminal in a local wireless telecommunications network performed at a locating system that provides a location estimation of the terminal depending on a set of configuration data and on a set of measuring data, wherein the network comprises a plurality of base stations providing services on a plurality of coverage areas," as recited by amended independent claim 21. Nor does Garceran disclose or suggest at least Applicants' claimed "processing system for locating a terminal in a local wireless telecommunications network by providing a location estimation of the terminal, wherein the network comprises a plurality of base stations that provide services on a plurality of coverage areas" as recited by amended independent claim 37.

Garceran generally discloses "a system for determining coverage in a wireless communications systems using location information for a wireless unit and collecting information on communications between the wireless unit and the wireless communications system in association with the location information." Garceran, col. 2, ll. 7-12. To that end, Garceran discloses that "during a call established between the wireless unit 54 and the serving base station 56, the serving base station periodically requests/receives/determines the wireless unit's position and receives associated

information from the wireless unit 54." *Id.* at col. 3, ll. 32-35. In the event that the serving base station receives the wireless unit's position, "[t]he wireless unit can determine and/or send the location information." *Id.* at col. 3, ll. 56-57. Garceran further discloses that

using the location of the wireless unit and collecting associated or corresponding data for the wireless unit at that location, the wireless communications system 50 can produce an RF database or storage 52 to represent or provide an RF coverage map for a geographic region serviced by a serving base station(s) and/or neighboring base stations.

Id. at col. 3, ll. 26-32.

Thus, Garceran merely discloses a system in which the location of a wireless unit is determined by the wireless unit or a base station and is then transmitted to either the base station or an RF database, respectively. See Garceran, col. 3, ll. 26-61. Garceran appears to contain no disclosure of the location determination of the wireless unit being performed by an apparatus other than the wireless unit itself or the base station. See *id.* By contrast, amended independent claim 21 requires that the "method for locating a terminal in a local wireless telecommunications network [be] performed at a locating system," while amended independent claim 37 requires "a processing system for locating a terminal in a local wireless telecommunications network." Further, both claims 21 and 37 make clear that the claimed "locating system" and "processing system" are distinct from "the network [that] comprises a plurality of base stations" and the terminal to be located.

Accordingly, Garceran fails to teach or suggest Applicants' claimed "method for locating a terminal in a local wireless telecommunications network performed at a locating system that provides a location estimation of the terminal depending on a set of

configuration data and on a set of measuring data, wherein the network comprises a plurality of base stations providing services on a plurality of coverage areas," as recited by amended independent claim 21 and Applicants' claimed "processing system for locating a terminal in a local wireless telecommunications network by providing a location estimation of the terminal, wherein the network comprises a plurality of base stations that provide services on a plurality of coverage areas" as recited by amended independent claim 37. Because Garceran does not disclose every element of claims 21 and 37, it cannot anticipate these claims. Claims 22-28, 32, and 38-40 depend from one of amended independent claims 21 and 37, and are therefore allowable for at least the same reasons. Thus, Applicants respectfully request that the rejection of claims 21-28, 32 and 37-40 under 35 U.S.C. § 102(e) be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Hussa and the rejection of claims 33-36 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Riley. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142. In this application, a *prima facie* case of obviousness has not been established because the scope and content of the prior art have not been properly ascertained, see M.P.E.P. § 2141, and thus, a reason why the prior art would render obvious the claims has not been articulated.

Applicants have already established that Garceran does not teach or suggest at least the claimed “method for locating a terminal in a local wireless telecommunications network performed at a locating system that provides a location estimation of the terminal depending on a set of configuration data and on a set of measuring data, wherein the network comprises a plurality of base stations providing services on a plurality of coverage areas,” as recited by amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Moreover, the Office Action's application of Hussa and Riley fail to cure the above-noted deficiencies of Garceran.

More particularly, the Office Action alleges that

Hussa teaches preliminary transfer operation, on a terminal of the network (mobile based positioning), . . . , of processing programs for performing at least one subset of locating procedures . . . , and configuration data bases (base station coordinates) used by the transferred locating procedures . . . , whereby the location estimation is performed by the terminal and information about estimated position and estimated accuracy are transmitted from the terminal to a locating system upon every service request.

Office Action, p. 7 (internal citations omitted). The Office Action further alleges “Hussa teaches the terminal performing signal measurement and calculates the location estimation.” *Id.* at p. 8. Regarding Riley, the Office Action alleges “Riley teaches a position estimate of a mobile station based on the barycenter (centroid) of a coverage area, and the uncertainty measured in association with the barycenter to all points of the area.” *Id.* at p 9.

Even assuming that the Office Action's characterizations of Hussa and Riley are correct, which Applicants do not concede, neither Hussa nor Riley teach or suggest the claimed “method for locating a terminal in a local wireless telecommunications network performed at a locating system that provides a location estimation of the terminal

depending on a set of configuration data and on a set of measuring data, wherein the network comprises a plurality of base stations providing services on a plurality of coverage areas," as recited by amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Accordingly, the cited references, taken either alone or in any reasonable combination, fail to teach or suggest all the recitations of claims 29-31 and 33-36. Thus, the Office Action has not articulated a reason why the claims would have been obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claims 29-31 and 33-36. Applicants therefore respectfully request the withdrawal of the Section 103 rejection of claims 29-31 and 33-36.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

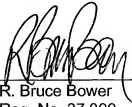
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 12, 2009

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